

IN THE
United States Circuit Court of Appeals
For the Ninth Circuit

CLAYTON T. EAID and JOSEPH A. McCONNELL
APPELLANTS

VS.

**TWOHY BROS. COMPANY, a Corporation,
THE NORTHWESTERN EQUIPMENT COMPANY,
a Corporation, and
ELBERT G. CHANDLER**
APPELLEES

UPON APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF OREGON

Appellants' Brief

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Filed

APR 19 1915

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Appellants,

vs.

TWOHY BROS. COMPANY, a corporation,
THE NORTHWESTERN EQUIPMENT
COMPANY, a corporation, and
ELBERT G. CHANDLER,
Appellees.

*Upon Appeal from the District Court of the
United States for the District of Oregon.*

Appellants' Brief

STATEMENT OF THE CASE

This is a suit in equity brought by the appellants as joint owners of U. S. Letters Patent No. 901815 issued October 20, 1908, to Joseph A. McConnell, upon Chock Attachment for Cars (Record, pp. 73-74).

Assignment of said patent by Joseph A. McConnell, patentee, one of the appellants, to the other appellant, Clayton T. Eaid, duly proven (Record, pp. 30-31) is shown on pages 75-76 of Record.

Appellees deny infringement, but admit in their answer (Record, p. 13) the manufacture and sale of "Log Bunk as fully illustrated, described and claimed" in U. S. Letters Patent No. 1066795, issued July 8, 1913, to Elbert G. Chandler, one of the appellees.

The manufacture of chocks under the said Chandler patent is moreover admitted by counsel for appellees (Record, p. 37).

The one question raised, and that by the pleadings, may be stated as follows:

Does the manufacture and sale of the subject matter described and claimed in the Chandler patent, aforesaid, constitute infringement of the McConnell patent of record (see Record, bottom p. 36 and top p. 37).

ASSIGNMENT OF ERRORS

I.

In decreeing that the plaintiffs are not entitled to the relief prayed for in the complaint.

II.

In decreeing that the McConnell patent set forth in the complaint and therein sued upon is not infringed by the structures and log bunks manufactured by the defendants.

III.

In decreeing that the plaintiffs were not entitled to an injunction restraining defendant from continuing to manufacture or sell said structures and log bunks manufactured by them under the Chandler patent.

IV.

In decreeing that the subject matter of the Chandler patent is substantially different from that defined in the claims of the McConnell patent, severally.

V.

In decreeing that the Chandler device is a marked advance upon the McConnell device.

VI.

In failure to recognize the prior state of the art upon which the McConnell patent is predicated.

VII.

In failure to ascribe to the McConnell patent its proper relationship to the prior art.

VIII.

In failure to allow to the McConnell patent the full benefit and scope of the language of the claims in construing the same.

IX.

In denying to the McConnell patent that liberal interpretation to which it is entitled under the law.

X.

In failure to extend the application of the doctrine of equivalents to the claims of the McConnell patent, *seriatim*, in determining their scope.

XI.

In reading into claim 1, line 6 of the McConnell patent a comma after the word "only" where none appears in the patent.

XII.

In limiting the construction of claim 1 of the McConnell patent upon the interpolation of a comma after the word "only" in line 6 thereof.

BRIEF OF LAW

CONSTRUCTION OF PATENT IN SUIT.

Where the language employed in the specification of a patent is clear and unambiguous, it must speak its own construction.

Mitchell v. Tilghman, 19 Wall. 287.

Patents for inventions are to receive liberal construction, to uphold and not to destroy the right of the inventor.

Winans v. Denmead, 15 How. 330.

Claims of a patent not held to literal interpretation.

Hoyt v. Horne, 145 U. S. 302.

Infringement sometimes made out though letter of the claims be avoided.

Westinghouse v. Boyden Power Brake Co.,
170 U. S. 537. Authorities cited.

Patent *prima facie* evidence that patentee is the original and first inventor.

Mitchell vs. Tilghman, 19 Wall. 287.

Patent *prima facie* evidence of novelty and utility.

Cammeyer vs. Newton, 94 U. S. 225.

The reasonable presumption is that, having a just right to cover and protect his whole invention, the patentee intended to do so.

Haworth vs. Hardcastle, Webster P. C. 484,
cited in Winans vs. Denmead, 15 How. 330.

When claims are fairly susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention.

McClain vs. Ortmyer, 141 U. S. 419.

The presumption is that an inventor intends to protect his invention broadly, and consequently the scope of a claim should not be restricted

beyond the ordinary meaning of the words, save for the purpose of saving it.

Andrews vs. Nilson, 27 App. D. C. 451.

Reference to the specification and drawings to be made in construing claims.

Bates vs. Coe, 98 U. S. 31-50.

But only for the purpose of enabling the Court correctly to interpret the claim.

Brooks vs. Fiske, 15 How. 215.

"Means" broad term

includes singular or plural number.
 Reed Mfg. Co., vs. Smith & Winchester Co., 2.
 123 Fed. 878. Any mechanism that will , 215.
 accomplish the result. Natl. Mach.
 Directory Co., vs. Polk, 58 C.C.A. 24 ART.
 [9th Cir.] Where the hand of the oper-
 ator assists in operation. Reed Mfg.
 Co., vs. Smith Winchester Co., knowledge, a
 123 Fed. 878. 59 C.C.A. 366. f the prior art

on the question of the validity of a patent in
 suit, unless the prior art is in evidence.

Stafford vs. Morris, 161 F. 113.

State of art may limit but not defeat a patent.

Imp. Bottle Cap & Mach. Co. vs. Crown Cork
 & Seal Co., 139 F. 312.

Patents not set up in answer may be introduced
 to show prior art, but not to invalidate patent for
 want of novelty.

Grier vs. Wilt, 120 U. S. 412.

PRINCIPLE OF INVENTION.

Principle is mode of operation.

Burr vs. Duryee, 1 Wall. 531.

An inventor must describe what he conceives to be the best mode of applying the principle of his invention, but he is not confined to that. The principle of an invention is a unit and invariable; the modes of its embodiment in the concrete invention may be numerous, and in appearance very different from each other.

Continental Paper Bag Co. vs. Eastern Paper Bag Co., 210 U. S. 405.

All modes, however changed in form, but which act on the same principle and effect the same end, are within the patent; otherwise a patent might be avoided by anyone who possessed ordinary mechanical skill.

McComb vs. Brodie, Fed. Cas. 8708.

After the patentee has fully described his invention, shown its principles, and claimed it in a form which perfectly embodies it, unless he disclaims other forms, he is deemed in law to claim every form in which his invention may be copied.

Murphy vs. Eastham, Fed. Cas. 9949.

Winans vs. Denmead, 15 How. 343.

That is called "principle" in a machine which

applies, modifies or combines mechanical powers and produces a certain result.

Smith vs. Pearce, Fed. Cas. No. 13089.

Where an invention is developed in different and independent forms, all original, and yet all bearing a somewhat general resemblance to each other, if one inventor precedes all the rest, and strikes out something which includes and underlies all that they produce, he acquires a monopoly and subjects them to tribute.

Chicago & N. W. R. Co. vs. Sayles, 97 U. S. 554.

Bona fide inventors of a combination may suppress every combination not substantially different from what they have invented and patented.

Seymour vs. Osborne, 11 Wall. 516.

When a party has invented some mode of carrying into effect a law of natural science or a rule of practice, it is the application of that law or rule which constitutes the peculiar feature of the invention. He is entitled to protect himself from all other modes of making the same application; and every question of infringement will present the question, whether the different mode, be it better or worse, is in substance an application of the same principle.

Sewall vs. Jones, 91 U. S. (1 Otto) 171-199.

McCONNELL PATENT A PIONEER

A pioneer patent is one which first discloses means to accomplish a certain result.

Natl. Dump Car Co. vs. Ralston Steel Car Co.,
172 F. 393.

A primary invention is "one which performs a function never performed by any earlier invention."

Western Electric Co. vs. Robertson, 142 F.
471.

Dictum: "We recognize, however, that the distinction between primary and secondary patents is now given less force than formerly by the courts, for EVERY PATENT MAY BE REGARDED AS PRIMARY WITHIN ITS FIELD; and it follows, then, that every patent should have as broad an interpretation as the courts may fairly give it, and as full and fair a use of the doctrine of equivalents as the Court may fairly allow it."

Kip-Armstrong Co. vs. King Phillip Mills, 130
F. 28.

DOCTRINE OF EQUIVALENTS.

Substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself.

Cochran vs. Deener, 94 U. S. 780.

Union Paper Bag Machine Co. vs. Murphy,
97 U. S. 120.

If two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, though they differ in name, form or shape.

Union Paper Bag Mach. Co. vs. Murphy, 97 U. S. 120.

A patentee is protected against equivalents for any part of his invention, whether he has claimed them or not.

Goodyear Vulcanite Co. vs. Davis, 102 U. S. 222.

In construing patents, the doctrine of mechanical equivalents is applicable to claims for combinations of old elements, and improvements on primary inventions, as well as to claims for primary inventions themselves.

Tatum vs. Gregory, (C. C.) 41 Fed. 142.

Where an inventor is entitled to the benefit of the doctrine of equivalents it is not essential that the equivalent does the same work in precisely the same way. It is sufficient that it accomplish the same result in substantially the same way.

Westinghouse Elec. & Mfg. Co. vs. Condit Elec. Mfg. Co., 158 F. 144.

Known equivalent is a known device substituted to effect the same result.

Morley Sewing Mach. Co. vs. Lancaster, 129 U. S. 263.

Every meritorious inventor entitled to benefit of the doctrine of equivalents according to amount of invention embodied in patent.

Commercial Acetylene Co. vs. Avery Portable Lighting Co., 166 F. 907.

The broader the invention the broader the range of equivalents.

Clark vs. Geo. Lawrence Co., 160 F. 512.

A patentee is entitled to the protection of the doctrine of equivalents in proportion to the nature of the advance which his invention indicates.

Continental Paper Bag Co. vs. Eastern Paper Bag Co., U. S. 210, 415-417.

American Can Co. vs. Hickmott Asparagus Canning Co., 142 F. 141.

Columbia Wire Co. vs. Kokomo Steel & Wire Co., 143 F. 116.

Though some of the corresponding parts of the machinery, designated in this combination, are not the same in point of form * * * and, separately considered, could not be regarded as identical or conflicting, yet having the same purpose in the combination, and affecting that purpose in substantially the same manner, they are the equivalents of each other in that regard.

Cochran vs. Deener, 94 U. S. 780.

See Evans vs. Eaton, 1 Robb. Pat. Cases 193.

FUNCTIONAL CLAIMS.

Definition of invention by function not patentable.

Burr vs. Duryee, 1 Wall. 531.

INFRINGEMENT.

In an action for infringement, the first question is, whether the machine used by the defendant is substantially in its principle and mode of operation, like the plaintiff's. If so, it is an infringement to use it.

Sewall vs. Jones, 91 U. S. (1 Otto) 171-199.

Where a patent is for means devised to produce a result, in an action for infringement the question is whether the defendants use the same or equivalent means.

Ives vs. Hamilton, 92 U. S. 426.

Neither multiplication or division of parts—joinder or separation—of elements will avoid infringement.

Nathan vs. Howard, 143 F. 889.

Lidgerwood Mfg. Co. vs. Lambert Hoisting Engine Co., 150 F. 364.

Where form and substance are inseparable, it is enough to look at the form only. Where they are separable, where the substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the

form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure; where that is found, there is an infringement; and it is not a defense, that it is embodied in a form not described, and in terms claimed by the patentee.

Winans vs. Denmead, 15 How. 343.

To infringe a patent, it is not necessary that the thing patented should be adopted in every particular. If the patent is adopted substantially by the defendants they are guilty of infringement.

Sewall vs. Jones, 91 U. S. (1 Otto) 171-199.

A patent for a combination is infringed by the use of a similar combination, although one of the elements is omitted and another substituted for it, unless the substituted device is a new one, or was not known at the date of the patent as a proper substitute for the one omitted.

Seymour vs. Osborne, 78 U. S. (11 Wall.) 516.

When the invention is embodied in a machine, the question of infringement is best determined by a comparison of the machine made by the respondent with the mechanism described in complainant's patent.

Blanchard vs. Putnam, 8 Wall. 426.

Seymour vs. Osborne, 11 Wall. 559.

Bates vs. Coe, 98 U. S. 31-50.

Actual inventors of a combination of two or more ingredients of a machine secured by letters patent in due form are entitled, even though the ingredients are old, if the combination produces a new and useful result, to treat every one as an infringer who makes and uses or vends the machine to others to be used without their authority or license.

Seymour vs. Osborne, 11 Wall. 559.

CHANDLER PATENT NO DEFENSE.

It is no defense in infringement proceedings to show that the infringing device was made in accordance with a later patent.

Blanchard vs. Putnam, 8 Wall. 420.

Electric Candy Mach. Co. vs. Morris, 156 F. 972.

A device is none the less an infringement because it contains an improvement upon the patented invention.

Elizabeth vs. American Nicholson Pav. Co.,
97 U. S. 126. **Westinghouse vs. Boyden**
Co., 170 U.S. 568-569.

A substantial equivalent of a patented device or means which performs the same function does not avoid infringement because it may perform an additional function.

Universal Brush Co. vs. Sonn, 146 F. 517.

Comptograph Co. vs. Mechanical Accountant Co., 140 F. 136; 145 F. 331.

The mere change of location of a joint in a machine, which does not change the substantial identity of the thing, or its operation and effect, does not prevent its use from being an infringement.

Brown vs. Guild, 23 Wall. 181.

To same effect, with enlarged particularity.

Whitely vs. Kirby, 11 Wall. 32.

One invention may include within it many others, and each and all may be valid at the same time. This only consequence follows: That each inventor is precluded from using inventions made and patented prior to his own, except by license from the owners thereof.

Cochrane vs. Deener, 94 U. S. 780.

A new idea may be engrafted upon an old invention, be distinct from the conception which preceded it, and be an improvement. In such case, it is patentable. The prior patentee cannot use it without the consent of the improver, and the latter cannot use the original invention without the consent of the former.

Smith vs. Nichols, 21 Wall. 112.

Presumption of patentable difference raised by a subsequent patent does not exclude the fact that the later patent may embody things which are the exclusive property of the complainant under a prior patent.

Electric Candy Machine Co. vs. Morris, 156 F. 972.

If one has taken the same plan and applied it to the same purpose, notwithstanding he may have varied the process of the application, his manufacture will be substantially identical with that of the patentee.

Sewall vs. Jones, 91 U. S. 171-199.

To like effect as foregoing see

Stebler vs. Riverside, 205 F. 735, and authorities collected therein.

BRIEF OF FACTS

THE McCONNELL PATENT.

This patent (see Record, p. 73) describes and purports to cover in broad terms a chock attachment for cars, otherwise known as a logging bunk, designed for the purpose of holding logs or timbers upon a car against dislodgment in transportation.

So far as relates to the present controversy, the patentee sets forth the object of this invention broadly to be, "to provide novel means whereby chocks can be moved into lowered position." The term "means" is one recognized to be of the broadest scope (Eastern Paper Bag Co. vs. Continental Paper Bag Co., 142 Fed. Rep. 479) and is employed without limitation not only in the claims, but in setting forth the object of the invention (McConnell Specification, p. 1, line 17).

Moreover, the invention is defined as consisting "of certain * * * combinations of parts (as) described and pointed out in the claims." (McConnell Specification, p. 1, lines 26 to 29.)

In respect to the form of embodiment of the invention described, it should be observed that it is presented preferentially only. (McConnell Specification, p. 1, line 31.)

The claims of the patent are ten in number, but infringement is not charged against the defendants in respect to claims 7, 8 and 9, and they may therefore be dismissed from consideration in this case.

In respect to all of the claims, the entity defined by each is described as "comprising" certain elements. The term "comprising" is recognized in patent practice to be of broad scope as contradistinguished from the term "consisting of," for example. The enumeration of elements called for under the latter term must be a complete enumeration, whereas under the former the enumeration is not inclusive of all, but only of so many as are necessary to constitute an operative whole.

Of the seven claims involved in this suit, the tenth claim is the broadest, and for that reason in the following analysis the tenth claim will be considered first, and the remaining claims in their order.

O'Leary
Utica,
139 Fed

Krajewski
vs. Pha
105 Fed
Smith v
Perkins
Fed. 285

McCONNELL'S 10TH CLAIM.

The tenth claim of the McConnell patent defines a combination comprising the following three elements, to-wit:

Standard
Dictionary

A wedge = 1. A chock.

2. Stop devices.

~~///~~

3. Means for lowering the chock to disengage it from said devices.

Element 2 is described as "for engagement with the chock when in one position," and element 3 is followed by the words "and for sliding the chock while in lowered position." The language of the claim in respect to language not included in the above analysis of elements 2 and 3 is of functional description only, and does not limit the scope of the claim. Functional description following an element may, in case of need to support a claim by differentiation from the prior art, be construed to qualify the element, but in the present case there is no such need and no necessity for any limitation of the three elements as enumerated, imposed either by the language of the patent or by the state of the prior art. Moreover, no construction which might be placed upon this claim in its entirety would, in this instance, be consequential.

The language of claim 10 is clear and concise, and unmistakably defines the invention in broadest scope. In respect to its first two elements, it postulates the presence in the combination of

two elements that are absolute essentials in any conceivable form of logging bunk. The language is broad enough to include any device of the prior art set up or even the wagon bolster, of use so common as to justify the Court in taking judicial notice of it under the authority of *Brown vs. Piper*, 91 U. S. 37.

Its matter is clearly differentiated by inclusion of the element 3, to-wit: "Means for lowering the chock to disengage it from said devices." It would not be possible to select a term broader or one more apt to define that element of indisputable novelty which lends patentability to the combination.

McCONNELL'S 1ST CLAIM.

Claim 1 defines a combination comprising the following elements, to-wit:

1. Parallel beams.
2. Means for securing the beams to a car platform.
3. Oppositely disposed chocks pivotally and movably mounted between the beams.
4. Fixed means for engaging the chocks when elevated.
5. Means carried by the beams for actuating the chocks.

Let it be observed that elements 2, 4 and 5 are couched in that broadest of terms "means." (*Vide* _____ *O'Reilly vs. Morse*, 15 How. 62, and *Eastern*

Re necessity for differentiation of claims:
de Ryder vs. Schlichter, 126 Fed. 487.
Myer vs. Keller Tool Co., 127 Fed. 130.
Winfield vs. Patts, 126 Fed. 475.
Tomson-Houston vs. Bassau Elec. Co., 110 Fed. 647.
 See Page 21.

Paper Bag Co. vs. Continental Paper Bag Co.,
142 F. 478.) Element 4 is restricted only by
the single qualification that the means must be
fixed. The statement "only to hold them against
sliding in one direction" is of function only. It
illustrates the definition of the combination covered
by the claim, but is required by no limitation
imposed by the language of the specification,
or by the prior state of the art. #

ERROR IN CONSTRUING CLAIM 1.

The Court below committed the error as set
forth in paragraphs XI and XII, Assignment of
Errors (Record, pp. 25-26), in reading into line 6
of the claim now under consideration a comma
after the word "only." Such reading imposes a
limitation upon the claim which the patent does
not contain, and which the prior state of the art
does not impose. Interpolation of the said comma
makes the adverb "only" to qualify the preceding
verb "elevated" instead of the succeeding
verb "to hold." Neither the utility of the device,
as is clear in view of the Chandler patent, nor the
prior state of the art demands that the fixed
means for engaging the chocks, when elevated,
shall engage them only when elevated. The
words "only to hold them against sliding movement
in one direction" cause the language of the
claim to harmonize with the demands of utility
and to supply the utmost differentiation which
the state of the art might require.

Nevertheless, the fact remains that under any
possible construction that may be placed upon the
words last above quoted, - wherever they appear -
the meaning is clear that the "fixed means" to
which they refer effect operative engagement with
the chocks only when the chocks are elevated.

The construction adopted by the Court below does violence to the patent, by narrowing the claim in disregard of the principle of law laid down by the Supreme Court in *McClain vs. Ort-mayer*, 141 U. S. 419, and enforced by the pre-sumption recognized in *Andrews vs. Nilson*, 27 App. D. C. 451.

It denies to appellant that liberal construction of his patent to which it is entitled under *Winans vs. Denmead*, 15 Howard 330, whose authority is unquestionable.

McCONNELL'S 2ND CLAIM.

Claim 2 defines a combination comprising the following elements, to-wit:

1. Beams.
2. Combined stop and guide devices fixedly carried thereby.
3. Chocks pivotally and slidably mounted within said devices.
4. Means carried by the chocks for engaging the devices.
5. Means carried by the beams for actuating the chocks.

The functional statement following element 4 is found in this claim substantially as in claim 1.

McCONNELL'S 3D CLAIM.

Claim 3 defines a combination comprising the following elements, to-wit:

Actuating "-definition Century Dictionary, 1889
 ge 63. "Actuate, 1, to move or incite to action"
 an electromagnet actuates an armature [example
 usage quoted], See also under "Syn."

1. Beams.
2. Combined guide and stop devices carried thereby.
3. Chocks pivotally and slidably mounted within said devices.
4. Means integral with the chocks for engaging the devices.
5. Separate means for elevating the chocks.

See "elevate"
as in gun-
nery, Stand-
ard Dictionary.

words "to limit the movement of the" in one direction" follow element 4. This language is of functional description, but could be, by any possibility, construed to limit the scope of the claim, inasmuch as limitation of movement in one direction does not preclude limitation of movement in more than one direction, if for any reason such limitation were desirable. The word "only" is omitted from the language following element 4 in this claim. Element 5 of this claim is believed to be, in view of the prior state of the art, entitled to a construction broad enough to include separate means for *keeping* the chocks elevated. It is true that this element is susceptible of a narrower construction if the state of the art demanded it, but the narrower construction is not imposed by the state of the prior art, and the nature of the invention warrants the broader construction. (See McClain vs. Ortmyer, 141 U. S. 419, and Arbetter vs. Lewis, 34 App. D. C. 491.)

McCONNELL'S 4TH CLAIM.

Claim 4 defines a combination comprising the following elements, to-wit:

1. Beams.
2. Combined guide and stop devices fixedly carried thereby.
3. Chocks pivotally and slidably mounted within said devices.
4. Means integral with the chocks for engaging the devices.
5. Means extending toward one end of the beams for actuating the chock adjacent to the other end thereof.

In the claim after its fourth element, the following functional statement appears: "Only when the chock is raised to limit the sliding movement of the chocks in one direction." There is obvious inadvertence in the use of the singular term "chock is" instead of the plural term, and the words are substantially equivalent to the functional statement in claim 3. The function called for is one required only when the chock is raised.

The five claims above reviewed define within their respective scopes the novelty of McConnell's invention.

The true meaning of those claims may be the more readily apprehended from a review of that summary of the novelty, utility and "principle"

of the invention presented elsewhere in this brief under section entitled, "*McConnell a pioneer inventor*," and to that section reference is here made.

McCONNELL'S 5TH CLAIM.

Claim 5 defines a combination comprising the following elements, to-wit:

1. Beams.
2. A chock pivotally and slidably mounted between the end portions thereof.
3. A shaft journaled within the beams.
4. A crank arm carried thereby.
5. A link connection between said arm and chock.
6. Means co-operating with the chock for limiting its movement in one direction.

The claim also contains the following functional statement: "Said crank arm and link being disposed to lock the chock in an elevated position."

McCONNELL'S 6TH CLAIM.

Claim 6 defines a combination comprising the following elements, to-wit:

1. Beams.
2. A shaft journaled therein.
3. Chocks pivotally and slidably mounted between the beams.

Definition: Link, 3. Any constituent part of a connected series." Century Dictionary, 1889, page 3468.

"Connection 1: Union by junction --- or by order of a series, Ib. page 1199.

4. Means co-operating with the chocks, for limiting the movement of each chock in one direction.

5. An arm upon each shaft.

6. A link connection between said arm and one of the chocks.

7. Crossed oppositely extending means for actuating the shafts.

This claim contains the functional description relative to elements 5 and 6, as follows: "Said arm and connection being disposed to lock the chocks in an elevated position."

STATE OF THE PRIOR ART.

The patent in suit, to-wit, McConnell No. 901895, issued upon application filed January 24, 1908. (Plaintiff's Exhibit A, Record, p. 73.)

The subsisting state of the prior art at that date is exhibited in U. S. Letters Patent No. 513124, C. D. Matheny, January 23, 1894. (Defendants' Exhibit 7, Record, p. 93.)

U. S. Letters Patent No. 790915, T. D. Parsons, May 30, 1905. (Defendants' Exhibit 8, Record, p. 95.)

U. S. Letters Patent No. 770899, M. Foshee, September 27, 1904. (Defendants' Exhibit 9, Record, p. 97.)

In addition to the prior art as set forth above, counsel for appellees also offered in evidence (Record, p. 71) Defendants' Exhibit 10, Defend-

ants' Exhibit 11, and Defendants' Exhibit 12. The offer was objected to upon the ground that none of the patents constituting said exhibits were certified or authenticated, and the Court below sustained the objection.

Introduced in the manner and at the time in which they were offered Defendants' Exhibits 10, 11 and 12 would, even without objection, be entitled to little, if any, consideration.

Charmbury vs. Walden, 141 F. 373.

Bell vs. Mackinnon, 149 F. 205. 255

Benbow Brammer Mfg. Co. vs. Heffron Tanner Co., 144 F. 429.

It is proper to add, however, that even the said Exhibits 10, 11 and 12 disclose no material addition to the state of the art.

Touching the art as shown of record, the earliest and the most pertinent contribution thereto is found in the Matheny patent (Defendants' Exhibit 7, Record, p. 93). That patent shows the only pivoted and transversely adjustable chock prior to the McConnell application. During the period of some fourteen years which elapsed between the date of issue of the Matheny patent and the McConnell application, no advance was made in the art in the direction of a pivoted and adjustable chock.

The Parsons patent (Defendants' Exhibit 8, Record, p. 95) shows an adjustable sliding block but neither a pivoted nor a depressible chock.

The Foshee patent (Defendants' Exhibit 9, Record, p. 97) shows a pivoted but non-adjustable bolster.

So far as appears Matheny's was no more than a paper patent, and his device never went into actual use in the art. The reason is not far to seek, but will be apparent, it is believed, from an examination of the patent, in view of the next paragraph.

Adverting only cursorily to the impracticable and inefficient means that support the chock C in the Matheny patent, to-wit, the strut C' and slotted plate S, the attention of the Court is particularly invited to the fact that MATHENY'S CHOCK C IS NOT ADAPTED TO DO THE WORK REQUIRED IN THE ART OF A TRANSVERSELY ADJUSTABLE CHOCK.

It is adjustable theoretically and on paper, but not practically. This statement, however extreme it may appear, is emphatically made in order to challenge contradiction, and will be found to be amply supported by the evidence, upon consideration, particularly, of Fig. 4 of the Matheny patent. From that figure, in view of the specification, it will be seen that the chock C cannot be adjusted when it is in the depressed position, but can be adjusted only when its strut or brace C' is lifted not only clear of the plate S, but also clear of the web that is superimposed above the plate S. Consequently the bunk or cross-pieces, upon which the logs in service rest, must be clear of logs in order to admit of proper adjustment of

the chocks C thereof. Now this condition is fatal to the use of the Matheny device in practice, because it is only when the logs are loaded in place upon the bunks that adjustment can be effected to any practical advantage.

It is this fatal defect in the Matheny device which McConnell overcomes, by a departure in principle from the Matheny invention, and that only after a lapse of some fourteen years, and when the Matheny patent had wellnigh expired.

It was in order to provide for the safe loading, transportation and unloading of the largest and heaviest logs that the art developed a demand for a pivoted, transversely adjustable, practicable chock. Matheny evidently conceived that a transversely adjustable pivoted chock would be desirable in the art, but he did not discover one which would work in practice. His position in the art is analogous to that of the unfortunate would-be inventor who conceives the existence of a demand for an improvement in an art, but who falls short of arriving at means for satisfying that demand.

McConnell was the first to produce a practicable, pivoted, transversely adjustable chock, and his improvement lies at the root of every improvement in that branch of the art that has followed after him. His invention is broadly a pivoted chock which may be adjusted while it is in the depressed position. By aid of such means he was the first one enabled to load a car with

logs or a single log and then to set the chocks, the same being pivoted, into snug contact with the load, thereby combining security in transportation with safety and facility in unloading.

In fine, McConnell is beyond question an absolute pioneer in a most important branch of the art.

McCONNELL A PIONEER INVENTOR.

The record shows that McCONNELL was the FIRST TO PRODUCE A LOGGING BUNK, of distinct utility, comprising a bed, as of parallel beams, designated by the numeral 3 of the drawing, in combination WITH STOP DEVICES AND PIVOTAL CHOCKS ADJUSTABLE lengthwise of the beams, AND ADAPTED TO BE RAISED and secured in position for the purpose of holding logs, OR TO BE LOWERED FOR THE PURPOSE OF ADJUSTMENT.

He was also the FIRST TO PRODUCE, in such a device, "MEANS BY LOWERING THE CHOCK TO DIS-ENGAGE IT FROM ITS STOP DEVICES."

He was also the FIRST TO PRODUCE, in such a device, "MEANS FOR LOWERING THE CHOCK IN ORDER TO SLIDE IT WHILE IN LOWERED POSITION."

He was also the FIRST TO PRODUCE, in such a device, "FIXED MEANS FOR ENGAGING THE CHOCKS WHEN ELEVATED."

He was also the FIRST TO PRODUCE, in such a device and for sliding the chocks, "COMBINED STOP AND GUIDE DEVICES FOR THE CHOCKS."

The language of the present section of this

brief points out broadly that which McConnell owned by clear right of discovery on January 24, 1908, when he made his application for patent. It was his clear right to make his claims within that scope, and that right, it is maintained, he has neither surrendered nor curtailed.

See *Winans vs. Denmead*, *supra*, 15 How. 330.

COMPARISON OF McCONNELL AND CHANDLER PATENTS.

Analysis and comparison of the McConnell and Chandler patents is facilitated by the parallel column arrangement subjoined, the reference numerals in the respective columns being those employed in the specifications of the respective patents.

The analysis of the McConnell patent presented above is followed in the comparison submitted below.

With reference to claim 10 of the McConnell patent:

McConnell Patent

1. "A chock" represented by the members 17 and 21.

2. "Stop devices" represented by the ratchet bars 15 and trunnions 18 provided with shoulders 20.

3. "Means for lowering the chock to disengage it from said devices" are represented by wrist pin 24, link 22, crank arm 25, shaft 5, arm 6, and operating bar 8.

Chandler Patent

1. "A chock"=9.

2. "Stop devices" = trunnions 10 and notched bracket members 6.

3. "Means for lowering the chock to disengage it from said devices"=lip 11 on the chock, the co-operative swinging member 12, and offset 15 upon the operating rod 13.

"Stop devices," called for as element 2 in claim 10 of the McConnell patent, are defined in the claim as being "for engagement with the chock when in one position." Even conceded that the Chandler stop devices make engagement in all positions, it follows therefore, of course, that they engage in any one position. The words "for engagement with the chock when in one position" therefore have no effect of limitation, but the contrary.

The stop devices shown in the Chandler patent are the trunnions 10 which engage and are held by the notches of the brackets 6. The slide of the trunnions 10 over the notches of the brackets 6 is substantially identical with the slide of the McConnell chock, the only difference being that the McConnell chock slides in a straight line, and the Chandler slides in an undulatory line (see Record, Expert testimony, p. 61).

There is, no doubt, advantage in the straight slide of the McConnell chock, and that is accomplished by the addition, in the McConnell device, to the shouldered trunnions 18, of ends projecting above the shoulders 20 so as to enter the opposite channeled guides 16 provided for their reception and guidance. The only difference obtained by Chandler in this respect is retrogressive in its nature, and is attained by the omission of the projecting ends of the McConnell trunnions 18 and their guide channels 16, with consequent loss of function. Without said pro-

jecting ends the McConnell chocks would be substantially identical, both in form and sliding movement, with the Chandler chocks.

It is demonstrable and will be shown to the Court, that the McCONNELL CHOCKS are as COMPLETELY OPERATIVE WITHOUT THE PROJECTING ENDS OF THE TRUNNIONS 18 as with them. ~~18~~

The uncontradicted testimony of a qualified and unquestioned expert is presented in support of the proposition, if any support were necessary, that the subject matter defined in the Chandler patent is in its several parts the substantial mechanical equivalent in every respect of the several elements called for in the combination defined in claim 10 of the McConnell patent. (See testimony of Clinton F. Blake, Record, p. 51.)

INTERCHANGEABILITY.

In *Miller vs. Eagle Mfg. Co.*, 151 U. S. 186, it is held that the interchangeability or non-interchangeability of the two devices in question is an important test in determining the question of infringement. In the face of this authority it is important to note the uncontradicted testimony of the expert Blake showing the entire interchangeability of the Chandler with the McConnell construction. (See Record, p. 61.)

Element 3 of claim 10 of the McConnell patent is couched in the broadest possible terms. The practice of the Patent Office is well defined. *Ex parte Halfpenny*, 73 O. G., p. 1135, allows the

use of the broad term "means," or "mechanism," qualified by words descriptive of its function, when the state of the prior art warrants the use of so broad a term and not otherwise.

A claim broadly drawn will be broadly read.

Ex parte Cutler, C. D. 1906, 249.

Limitation of a claim by mere interpretation or construction condemned.

Briggs vs. Lillie *et al.*, C. D. 1905, 168.

The granting of claim 10, in particular, with the element 3, defined as it is in the patent, is therefore evidence of the broad intent and scope of the patent.

The position is moreover held that the complete definition of the third element of claim 10 is found in the words "means for lowering the chock to disengage it from said devices," and that the words following, "and for sliding the chock while in lowered position" are not only not definitive of a difference of function but are mere surplusage, being descriptive only of the operation which may ensue upon the lowering of the chock.

Analogous to point decided *ex parte* Holder, 1903 C. D. 442.

Adverting to the prior state of the art, and particularly to the Matheny patent set up therein, the same showing the first and only transversely adjustable pivoted chock known to the prior

art, it will be found that Matheny shows elements 1 and 2 of claim 10 of the McConnell patent, but fails to anticipate the combination defined in said claim for lack of element 3. As is elsewhere pointed out in this brief, Matheny's chock, although pivoted and ostensibly adjustable, is locked in place when lowered and must be lifted almost vertically in order to disengage it from its stop devices. This, as will be shown at the hearing, is fatal to the practical utility of the MATHENY BUNK, because it PROHIBITS ADJUSTMENT OF CHOCK ON THE BUNK WHEN LOADED. Any transverse adjustment except to accommodate a load in place on the bunk is A FUTILITY IN THE ART.

This proposition is advanced, under Assignment of Error, V, in contravention of the finding of the Court below, that the Chandler device is a marked advance upon the McConnell device. (See Record, p. 21.)

Disengagement of the chock from the stop devices referred to in element 3 is operative disengagement, or in other words, such disengagement as will when effected admit of the sliding of the chock in the lowered position. The nature of the disengagement is aptly described in the testimony of the expert Blake (Record, p. 59), where he says, "When the chock in the Chandler patent is lowered, while it is true that the trunnions 10 would still rest on the corrugations, it would be disengaged to the extent that it would

(could) then be moved—it is still engaged with the piece 6 but not in an operative sense, in the same manner that it was before.”

Despite denial that the language employed tends at all to limit claim 10, see

Arbetter vs. Lewis, 34 App. D. C. 491.

Analysis and comparison of the McConnell and Chandler patents with reference to claim 1 of the McConnell patent:

McConnell Patent

1. Parallel beams=3.
2. Means for securing the beams to a car platform=**beams 3 in connection with bolts 2.**

3. Oppositely disposed chocks pivotally and movably mounted between the beams=17—21.

4. Fixed means for engaging the chocks when elevated=ratchet bars 15.

5. Means carried by the beams for actuating the chocks=the same as those described in analysis and comparison with reference to claim 10, *supra*, under “McConnell Patent.”

Chandler Patent

1. Side pieces 1 and 2.
2. Side pieces 1 and 2 in connection with additional means implied.

(See testimony C. F. Blake, Record, p. 53.)

3. Chocks 9.

4. Bracket members 6.

5. The same as those described in analysis and comparison with reference to claim 10, *supra*, under “Chandler patent.”

The functional language of claim 1 of the McConnell patent has been referred to under “McConnell’s 1st claim,” *supra*, and need not be here repeated.

It is submitted, in view of the foregoing, that the Chandler construction reads upon claim 1 of the McConnell patent element for element with the sole exception of element 5, in which a colorable variation only of the means called for by McConnell is resorted to by Chandler.

Furthermore, it is submitted that the said variation is clearly colorable only in that it embodies elements well known and of familiar use at the time McConnell made his application for patent, and that they do the same work in substantially the same way and accomplish substantially the same result. (Union Paper Bag Mach. Co. vs. Murphy, 97 U. S. 120.)

The said means are under the authority last cited, submitted to be the same.

See also testimony Expert Blake, Record, pp. 51-52.

A like comparison of each of the remaining claims alleged to be infringed might be made, to correspond with that submitted with respect to claims 10 and 1, and all leading to the conclusion that the Chandler construction infringes the McConnell patent throughout, so far as alleged. It is believed, however, to be sufficient, in this brief, to refer to the careful analysis submitted of McConnell's claims 2, 3, 4, 5 and 6 respectively, and leave to the Court the comparison thereof with the Chandler construction.

Now, "an infringement involves substantial identity, whether that identity be described by the terms, 'same principle,' same 'modus operandi,' or any other. It is a copy of the thing described in the specification of the patentee, either without variation, or with such variations as are consistent with its being in substance the same thing. If the invention of the patentee be a machine, it will be infringed by a machine which incorporates in its structure and operation the substance of the invention; that is, by an arrangement of mechanism which performs the same service or produces the same effect in the same way, or substantially the same way." Curt. Pat., 322.

Quoted with approval *Burr vs. Duryee*, 1 Wall. 531.

Upon the foregoing, comparison of the subject matter of the Chandler patent with the McConnell patent, in view of the prior art, discloses the fact, it is submitted, that Chandler employs a device but slightly changed even in form from the McConnell construction, to do the same work, in substantially the same way, and to accomplish substantially the same result. The Chandler device must therefore be held to come within the principle of the McConnell invention and to constitute an infringement of the McConnell patent.

Union Paper Bag Machine Co. v. Murphy,
97 U. S. 120.

Seymour v. Osborne, 11 Wall. 516.

Westinghouse v. Boyden P. B. Co., 170 U.
S. 537.

Respectfully submitted,

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